

Office Action, *i.e.*, for the same reason as in paragraph 6 of the October 1, 2001 Office Action. Applicants respectfully traverse.

The previous Office Action concedes that Biggs does not disclose that the shape is a cone, or the size and step of allowing the confectionery to harden. The Office Action also states that all other variables are obvious to optimize: the product shape, the product size, the type of filling and texture desired, the use of inclusion. By this logic, a transistor would not have been patentable over a vacuum tube, since it would be obvious to create a structure of a different size with different components in a different arrangement and in an overall different shape that performed a similar function. Applicants respectfully submit that this is an improper hindsight rejection, using the specification as a template and simply optimizing every single variable. While it may be obvious to modify one or two aspects of a disclosure, it is clearly not obvious to modify every feature to allegedly arrive at a teaching of a claimed invention.

In reality, Biggs is directed to a process for manufacturing a food product, wherein a food core is pre-formed, then a wafer is heated to become deformable, and then the deformable wafer is shaped around the pre-formed food core. Biggs also discloses that the food core may comprise "any desired ingredients such as ice cream, fish, meat, vegetables, fruit, nuts, chocolate pieces and the like. Preferably, the food core is ice cream" (Col. 1, lines 61-66). Inherently, the food core must be sufficiently solid to have a wafer formed around it. Biggs does not teach the combination of a filling of a substantially water-free based confectionery material in a sugar wafer cone, as presently recited, to provide a food product that is eaten like ice cream but is not ice cream. Biggs has absolutely no teaching in this regard, and it is directed only to an improved way to form a wafer around a pre-formed food core. At best, Biggs teaches that a sugar wafer of any of a variety of shapes can be prepared with any of a variety of food products inside of it. Thus, Biggs at best teaches a vast genus of shape/food product combinations, but it fails to teach the specific combination presently recited, as well as other features noted below. This combination surprisingly and unexpectedly provides a delightful ice cream-like product that is not ice cream. More importantly, Biggs teaches to use ice cream and various other water-containing food products. The present claims specifically limit the use of such water-based filling materials, which can have an adverse effect on the sugar wafer cone. Specifically, claim 1 recites the filling is a substantially water-free based confectionery material, such that Biggs actually *teaches away* from the present invention by suggesting water-containing fillings are preferred, *i.e.*, ice cream. No *prima facie* case of obviousness has been shown since Biggs

fails to teach the specific shape/filling combination, particularly in view of Biggs teaching away from the claimed substantially water-free filling.

Moreover, most of the specific foods listed in Biggs are not even fat-based confectionery products, and none are introduced into the sugar wafer cone from a molten, semi-liquid, or semi-solid state that solidifies prior to consumption so as to form a product that fits in the claimed cone shape, since Biggs *teaches away* from forming products in this manner by forming the food core first. This difference is not a "mere process step" that is irrelevant to the product. Indeed, Biggs cannot obtain the claimed structure because it teaches pre-forming the food core and then providing a shaped wafer. Since Biggs does not even suggest forming a cone-shaped filling *first*, and then forming the wafer around such a shape, it cannot obtain the claimed product where the sugar wafer cone acts to mold the shape of the filling.

The fact that Biggs teaches an food core that is preferably *ice cream* shows that Biggs is not concerned with a food product that will solidify, such as to avoid melting in hot weather or during prolonged handling as is typical with ice cream products (*See* Specification, page 2, lines 17-18). Indeed, Biggs is directed to the unique problems of forming sugar wafer cones that are *open*, *i.e.*, do not define an enclosed space. Thus, Biggs does not teach a cone that acts as a handle to keep a user's hands clean during eating of the confectionery product, as presently recited.

Furthermore, claim 5 recites a more specific combination of substantially water-free confectionery material filling with a specific amount of chocolate and from about 10 to 40 percent vegetable fat. Biggs completely fails to suggest this filling, particularly in combination with the other features recited in claim 1. Claim 6 recites an even more specific combination of filling materials of chocolate and non-lauric vegetable fat. These features are clearly not taught by Biggs, and would likely result in a filling that--while solidified after provided into the wafer--would be too soft to form a wafer around as per Biggs' process. New claim 20 recites 20 to 60 weight percent of flour in the sugar wafer cone, in combination with the features of the filling recited in claim 5 and the other distinct features of claim 1. Biggs teaches only 67 weight percent flour in its wafer. The wafer composition can be important to avoiding fat migration from the filling into the wafer (*See, e.g.*, Specification at page 4, lines 16-32). Claim 20 also recites that a top portion of the filling is domed to provide the food product with an ice cream-like appearance. Biggs fails to teach such a structure, particularly in combination with the other features recited in independent claim 1. Thus, claims 5-6 and 20 are even more clearly distinct from Biggs.

With respect to process claims 10-17 and new claim 21, Biggs teaches a completely different process. In particular, claims 10, 11, and 21 and several claims depending therefrom recite processes of making a sugar confectionery product by providing the sugar wafer in a desired shape and then adding the confectionery filling. Even if the resultant product is identical to the Biggs product, which it is not, this fact would not render the process claims obvious in view of Biggs. Indeed, Biggs discloses pre-forming a food core, heating at least a portion of a wafer, and shaping the wafer around the food. Claims 10-11 of the present invention, however, recite providing the sugar wafer in a desired shape, and then introducing a substantially water-free fat-based confectionery in a molten, semi-liquid, or semi-solid mass upon or into the shaped sugar wafer, and then allowing the confectionery to harden. Claim 11 in part further recites that the desired shape is a cone. Biggs fails to teach forming a wafer in a desired shape and *then* providing the molten filling. In fact, Biggs *teaches directly away* from this process by requiring pre-forming of the food core and *then* shaping the wafer around the core. The Examiner suggested at the interview that the claim term "introducing" was not sufficient to distinguish over Biggs, however, this is irrelevant since Biggs teaches away from the order of preparation presently claimed.

Moreover, the *molten filling* of the present claims is not pre-formed and would not be conducive to shaping a deformable wafer around it, as taught by Biggs. Instead, claims 10-11 recite that the molten confectionery material is filled upon or into the previously shaped wafer, and the filling is allowed to solidify prior to consumption. Biggs cannot render obvious the process claims since it teaches directly away from the recited process steps. Moreover, Biggs does not even suggest the substantially water-free fat-based confection of claim 10 as a filling or the combination of such a filling with a cone shaped wafer in claim 11. Indeed, Biggs teaches away from such process by suggesting that the presence of water is preferred in many of its specifically enumerated fillings, including at least ice cream, vegetables, and fruit, all of which have a well known water content. At best, Biggs fails to teach substantially avoiding the water in the filling. Also, new claim 21 recites that the filling is introduced by filling the shaped sugar wafer, which is not taught by Biggs.

Other dependent claims recite further differences over Biggs. Claims 3 and 13 recite that the product has a weight of between about 5 and 40 g and is bite-sized or a 2-3 bite sized piece. Also, claims 17 and 19 recite that the food product may include a topping. Claim 17 also recites that the top of the filling is shaped into a dome to provide the appearance of ice cream, which dome shape process is not taught by Biggs. As Biggs does not disclose these features, these claims are further distinguished from the teachings of Biggs.

For these reasons, the rejection of claims 1 and 3-19 under 35 U.S.C. § 103(a) should be reconsidered and withdrawn, since a *prima facie* case of obviousness has not been stated on the record.

Accordingly, the entire application is now in condition for allowance, early notice of which would be appreciated. Should the Examiner not agree with the Applicants' position, then a personal or telephonic interview is respectfully requested to discuss any remaining issues and expedite the eventual allowance of the application.

An RCE transmittal is submitted herewith to avoid introducing new issues after final. No fee is believed to be due for this submission. Should any fees be due, however, please charge such fees to Winston & Strawn Deposit Account No. 501-814.

Respectfully submitted,

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Date

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## APPENDIX A - MARKED UP CLAIMS

5. (Twice Amended) A food product according to claim 1, wherein the food product has a weight of [between about 5 and 40 g] 5 to 40 g and is bite-sized or a 2-3 bite sized piece.

10. (Amended) A process for preparing a food product comprising a sugar wafer having a substantially water-free fat based confectionery filling which comprises providing the sugar wafer in a desired shape, introducing a substantially water-free fat-based confectionery in a molten, semi-liquid or semi-solid mass upon or into the shaped sugar wafer, and allowing the confectionery to harden to form the food product.

13. (Amended) A process according to claim 11, wherein the food product has a weight of [between about 5 and 40 g] 5 to 40 g and is bite-sized or a 2-3 bite sized piece.

17. (Amended) A process according to claim 11, which further comprises forming a top portion of the filling into a dome to provide the appearance of an ice cream cone and providing a topping of chocolate, a confectionery coating, chopped nuts, candy pieces, raisins or any mixture thereof.

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